

REMARKS

Reconsideration of the application is requested. Claims 1, 4-10, 13, 15, 19, 31, 32, 35, 37-39, and 48-51 remain in the application. In this Response, which takes the entry of the Response filed November 10, 2010 into consideration, claims 31, 48, 49, and 51 have been amended.

Applicant believes the claim amendments and the accompanying remarks herein serve to clarify the present invention and are independent of patentability. No new matter has been added.

Claim Rejections Under 35 USC § 101

Claims 1, 4-10, 13, 15, 19, 30-32, 35, 37-39, 41, and 46-50 were rejected under 35 USC § 101 as being drawn to non-statutory subject matter. In particular, it was asserted that independent claims 30 and 41 each “positively recites part of a human, *i.e.* the implant being fixed to only the first bone.” Applicant respectfully disagrees. The mere mention of a part of a human does not give rise to impermissibly claiming the human body. In this regard, Applicant notes that no part of the human body is positively claimed. The bones described in the claims are never positively claimed. Rather, the bones are the work piece with which the positively claimed device interacts. See MPEP § 2115. The bones are only inferentially introduced and not positively claimed. Accordingly, the claims do not positively claim natural subject matter.

In any event, claims 30 and 41 (as well as dependent claims 30, 46, and 47) have been canceled. However, the claims were not canceled for reasons relating to the Section 101 rejection. Independent claims 30 and 41 were canceled in favor of new claim 51, which clarifies the invention as claimed.

Claim Rejections Under 35 USC § 112

Claims 1, 4-10, 13, 15, 19, 30-32, 35, 37-39, 41, and 46-50 were rejected under the second paragraph of 35 USC § 112 as being indefinite. Without conceding the validity of this rejection and as noted above, independent claims 30 and 41 (as well as dependent claims 30, 46, and 47) have been cancelled. According the indefiniteness rejection is now moot.

Claim Rejections Under 35 USC § 103(a)

Claims 1, 8, 9, 13, 15, 19, 30-32, 35, 37-39, 41, and 43-45, and 47-50 were rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 6,008,433 to Stone (“Stone”) in view of U.S. Patent No. 5,609,635 to Michelson (“Michelson”) and U.S. Patent No. 6,066,175 to Henderson *et al.* (“Henderson”). Claims 4-7 were rejected under 35 USC § 103(a) as being unpatentable over Stone in view of Michelson and Henderson further in view of U.S. Patent No. 4,394,370 to Jefferies (“Jefferies”). Claim 10 was rejected under 35 USC § 103(a) as being unpatentable over Stone in view of Michelson and Henderson further in view of U.S. Patent No. 5,669,909 to Zdeblick *et al.* (“Zdeblick”). For reasons set forth below, Applicant respectfully submits that these rejections should be withdrawn.

As an initial matter, claims 30, 41, 46, and 47 have been cancelled without prejudice and without conceding the rejection, thereby rendered the rejection to these claims as moot. Furthermore, the references are described individually only to clarify what each reference teaches. Thus, presentation of individual descriptions of the references is not and should not be interpreted as an attempt “to argue the references separately.” Finally, Applicant notes that Stone, Michelson, Henderson, Jefferies and Zdeblick have been discussed in prior Responses. This discussion is incorporated herein by reference and will not be repeated in this interest of brevity.

Independent claim 51 is now directed to an implantable device for changing a spatial relationship between a first bone and a second bone in a joint. The device comprises a first surface configured to abut the first bone; a second surface configured to abut the second bone; a unitary body interconnecting said first surface and said second surface; a side surface connecting said first surface and said second surface; and a channel extending through said first surface and said side surface. The channel is configured and dimensioned to receive a fastener for fixedly connecting said body to the first bone and the channel includes a recess configured to receive a portion of a fastener wider than the channel.

Thus, claim 51 recites structural elements that the body is unitary, a channel extends through a first surface to a side surface, with the channel configured and dimensioned to receive a fastener for fixedly connecting said body to the first bone and with the channel having a recess

on the side surface that is wider than the rest of the channel. The recess keeps the fastener from protruding past the side surface.

With respect to Stone, when considered as a whole, there is nothing to teach or suggest the structure as set forth in claim 51, *e.g.* any channel that extends from one surface contacting the bone to a side surface. Furthermore, claim 51 specifically recites the channel extending through said first surface to said side surface, with the channel configured and dimensioned to receive a fastener for fixedly connecting said body to the first bone and with the channel including a recess for receiving a portion of the fastener wider than the channel. Such structure is missing from Stone.

Although Henderson does teach an implant with fasteners extending diagonally, the implant does not have a unitary body nor is there anything resembling a recess to prevent the fastener from protruding past the implant surface. Michelson teaches a porous implant that has spikes extending through superior and inferior surfaces. In summary, Henderson and Michelson do nothing to remedy all the deficiencies of Stone.

Jefferies and Zdeblick also do nothing to remedy the deficiencies of Stone, Michelson, and Henderson. Accordingly, none of the references, whether taken alone or in any combination, either show or suggest the features of claim 51. Therefore, claim 51 is patentable over the art. And, because all of the dependent claims ultimately depend from claim 51, they are believed to be patentable as well at least for the same reasons.

In light of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the §103 rejections.

Conclusion

In light of the foregoing remarks, this application is now in condition for allowance and early passage of this case to issue is respectfully requested. If any questions remain regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

Fees for an extension of time are believed to be due for this submission and are being paid by credit card. However, please charge any required fee (or credit overpayments) to the Deposit Account of the undersigned, Account No. 500601 (Docket No.780-A03-021-5).

Respectfully submitted,

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